

Durbin et al.

S/N: 09/683,561

**REMARKS**

The Examiner's application of Official Notice is inappropriate under the Manual Patent Examining Procedure (MPEP). "The Examiner may take Official Notice of facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art." MPEP §2144.03. However, MPEP §2144.03 is clear that "such rejections [relying on official notice] should be judiciously applied," be "rare," and be used "[i]n limited circumstances." Furthermore, "any facts so noticed should be of notorious character and serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection." MPEP §2144.03. Applicant does not believe that the Examiner's use of Official Notice is merely to "fill in the gaps." That is, the Examiner took Official Notice of an entire element of the claims, thereby effectively attempting to fill in apparent "holes" in the rejection rather than "gaps." The use of Official Notice is hereby traversed. The Examiner must "cite a reference in support of his or her position" should the Applicant traverse the assertion. MPEP § 2144.03. The reference cited by the Examiner, Fenstermaker, is inadequate for the Examiner's proposition.

The Examiner's Official Notice that receiving authorization codes through email is old and well established in the art of software activation as a method of quickly receiving the activation code without the need for paper, as evidenced by U.S. Patent 6,490,684 to Fenstermaker (col. 3, lines 1-4), is in error.

The full text of Fenstermaker (col. 2, line 55 through col. 3, line 26) discloses:

Unlike features installed in conventional ultrasound devices, at least some of the features installed in the ultrasound device 100 of this preferred embodiment are not immediately available for use (i.e., at least some features are installed disabled). To use a disabled feature, the ultrasound device 100 is supplied with a key operative to enable the disabled feature (step 220). The key can be supplied to the ultrasound device 100 either locally or remotely. FIG. 3 is a flow chart of a method for locally supplying the ultrasound device with a key operative to enable a disabled feature. First, a user receives the key from, for example, an ultrasound device vendor (step 310). The user can receive the key when he orders an ultrasound device or when he later orders an additional feature from the vendor. The key can be in the form of alphanumeric symbols that can be supplied to the user in writing, over the phone, via email, or via facsimile, for example. The key can also be embodied on removable media, such as magnetic or optical devices, for example. Next, using the feature control manager 130, the user selects a feature control function to enable the use of a disabled feature (step 320).

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Preferably, the feature control manager 130 determines which features are enabled and disabled and presents this information to the user. Then, the user selects the feature to be enabled and enters the key via the key receiver 150 (step 330). If the key is in the form of alphanumeric symbols, the key receiver 150 can be a user interface such as a keyboard, optical scanner, or voice recognition device. If the key is embodied on removable media (e.g., a magnetic disc), the key receiver 150 can be adapted to receive such removable media (e.g., a magnetic disc drive). It is preferred that the feature control manager 130 verify the received key to ensure that it will enable the requested feature and provide an acknowledgement of the verification to the user (step 340). For example, if the key is verified, the feature control manager 130 can provide the user with an updated list showing which features are enabled and which are disabled. Additionally, if the key fails, the feature control manager 130 can display a failure message to the user. It is important to note that although the method described above is preferred, other methods can be used.

Claim 23 depends from claim 22. Claim 22 requires that the alphanumeric code be conveyed automatically. Nothing in the aforementioned section of Fenstermaker leads one to believe that the conveyance is automatic. In fact, just the opposite is what is disclosed by Fenstermaker because it states that "a user receives the key from, for example, an ultrasound device vendor (step 310)."

"It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." MPEP § 2144.03 citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). It is insufficient to allege that receiving authorization codes through email is old and well established. Rather, the Examiner must establish that such was well known at the time of invention and within the context and use claimed. Applicant believes that at the time of invention, "automatic" conveyance of the alphanumeric code to the user is not old and well established. This application was filed January 18, 2002. Fenstermaker is actually evidence that such automatic conveyance was not known since it discloses conveyance from the vendor, for example.

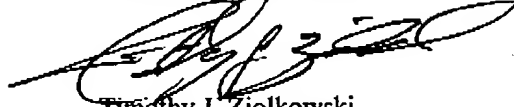
"The requirement 'at the time the invention was made' is to avoid impermissible hindsight." MPEP §2141.01. Applicant believes the Examiner's use of Official Notice in this regard is evidence of impermissible hindsight reconstruction.

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Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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